

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:
	:
Koichiro TANI	: Confirmation No. 2067
	:
Serial No. 10/673,258	: Group Art Unit: 3761
	:
Filed: September 30, 2003	: Examiner: Melanie Jo Hand
	:
For: DISPOSABLE DIAPER	

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Attn: BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellant hereby files this reply brief to the Examiner's Answer mailed May 30, 2008.

Appellant respectfully traverses all Examiner's arguments indicated in the "Grounds of Rejection" and "Response to Argument" sections of the Examiner's Answer. In the following ARGUMENT section, Appellant will address the Examiner's arguments indicated in the "Response to Argument" section *only*. Any remaining issues are believed to have been sufficiently and adequately treated in the Appeal Brief filed January 23, 2008.

STATUS OF CLAIMS

A. Total Number of Claims in Application

There is a total of 19 claims in the application, which are identified as claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26.

B. Status of all the claims

1. Claims cancelled: claims 2, 6, 11, 14, 16, 18, 21
2. Claims withdrawn from consideration but not cancelled: none
3. Claims pending: claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26
4. Claims allowed: none
5. Claims rejected: claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26

C. Claims on Appeal

Claims on appeal are claims 1, 3-5, 7-10, 12-13, 15, 17, 19-20, 22-26 as rejected by the Final Office Action dated August 22, 2007.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The 35 U.S.C. 103(a) rejection of all claims on appeal as being unpatentable over *Robles* (U.S. Patent No. 6,004,306).

ARGUMENT

35 U.S.C. 103(a) rejection of all claims on appeal as being unpatentable over Robles

Claim 1

The Examiner's response ¹ to Appellant's arguments is noted.

First, the Examiner interpreted the *Robles* intermittent bonding as comprising "a series of bonding points, regions or zones separated in all directions" ² and then argued that there are bonds in *Robles* that are separated in the width direction as presently claimed. Appellant respectfully disagrees at least with the Examiner's interpretation of "intermittent bonding" as highlighted above. There is no evidence in both *Robles* and the knowledge generally available in the art that a person of ordinary skill in the art would understand the term "intermittent bonding" as over-broadly interpreted by the Examiner.

Next, the Examiner cited ³ a new section of *Robles*, that has never been applied before, in support of her allegation that the extensible panels are bonded to the main diaper assembly in various sizes and patterns. The newly cited section, i.e., column 23 lines 32-43, is reproduced herein below:

Alternatively, the extensible side panel 30 can be constructed out of extensible materials having areas of different elastic behavior achieved by means other than the aforementioned mechanical operations, such as slitting, cutting, bonding or folding the extensible material that forms the extensible side panel. In such embodiments, the slits, folds, bonds or cuts in the material are not limited to any particular sizes or shapes. For example, the material making up the extensible side panel 30 may be fully or partially severed or may have portions cut out or bonded to create different extensibility characteristics in the extensible side panel 30.

It would be apparent to a person of ordinary skill in the art that the newly cited section discloses how internal bonds can be made inside the side panel 30 to vary its extensibility characteristics. The newly cited section fails to teach or disclose external bonds that bond the *Robles* side panel 30 to the main diaper assembly and that are considered by the Examiner to

¹ Examiner's Answer, at the paragraph bridging pages 10-11.

² Examiner's Answer, at page 10, line 10.

³ Examiner's Answer, at page 10, the last line.

meet the claimed fixing and joint parts. As such, the newly cited section is irrelevant to the claim features at issue, i.e., fixing and joint parts where each of the side flaps is fixed to the diaper body.

Further, the Examiner responded ⁴ to Appellant's argument regarding point (c).⁵ Appellant respectfully submits that, although "intermittent bonding" might imply that adjacent bonded regions are spaced from each other, there is absolutely no evidence in *Robles* that such adjacent bonded regions are spaced from each other in the width direction as presently claimed.

The Examiner also responded ⁶ to Appellant's argument regarding point (d).⁷ Appellant respectfully submits that the cited teachings in particular and the *Robles* reference as a whole would have motivated, if at all, a person of ordinary skill in the art only to vary sizes and/or shapes and/or patterns of the internal bonds between layers of the side panel 30 as such internal bonds have been disclosed by *Robles* to result in different extensibility characteristics. The person of ordinary skill in the art would not have varied sizes and/or shapes and/or patterns of the external bonds between the side panel 30 and the diaper assembly as proposed by the Examiner, because there is no evidence in the current record that such modifications would have yielded a desirable result. Without being properly modifiable to vary sizes/shapes of the external bonds, the *Robles* reference fails to teach or suggest the claimed fixing and joint part arrangement.

Finally, the Examiner responded ⁸ to Appellant's argument 2,⁹ using the same arguments. Thus, the Examiner's response is traversed for one or more of the reasons detailed above.

⁴ Examiner's Answer, at page 11, lines 3-10.

⁵ Appeal Brief, at page 15.

⁶ Examiner's Answer, at page 11, lines 10-14.

⁷ Appeal Brief, at page 15, the last full paragraph.

⁸ Examiner's Answer, at page 11, lines 15-17.

⁹ Appeal Brief, at pages 16-17.

Each and every argument of the Examiner has been traversed. Reversal of the rejection of independent claim 1 is now believed appropriate and therefore respectfully requested.

Claim 15

Claim 15 is patentable over *Robles* for one or more reasons detailed *supra* with respect to the Examiner's response to Appellant's arguments advanced in the Appeal Brief with respect to claim 1, at 2 and (d).

Claim 17

The Examiner responded ¹⁰ to Appellant's additional argument regarding claim 17, repeating her argument that the *Robles* disclosure of internal bonds within the side panel 30 would have motivated a person of ordinary skill in the art to have varied sizes and/or shapes and/or patterns of the external bonds between the side panel 30 and the diaper assembly. Appellant respectfully disagrees for at least the reason detailed above with respect to claim 1, i.e., no person of ordinary skill in the art would have made the Examiner's proposed modifications.

Without being properly modifiable to vary sizes/shapes of the external bonds, the *Robles* reference fails to teach or suggest the claimed step of adjusting positions of the fixing and joint parts, and hence does not render obvious the invention of claim 17.

Claim 19

The Examiner's obviousness rationale is improper for the reason detailed above, i.e., the *Robles* disclosure of internal bonds within the side panel 30 would *not* have motivated a person of ordinary skill in the art to have varied sizes and/or shapes and/or patterns of the external bonds between the side panel 30 and the diaper assembly.

¹⁰ Examiner's Answer, at the paragraph bridging pages 11-12.

Since *Robles* is not properly modifiable in the manner suggest by the Examiner, the reference fails to teach or suggest the claim feature “one of the first and second joint parts is closer to the respective side edge of the diaper body than the other.”

Claim 20

The Examiner responded ¹¹ to Appellant’s additional argument regarding claim 20, again alleging that *Robles* teaches/suggests varying the sizes of the external bonds between the side panel 30 and the diaper assembly.¹² Appellant respectfully disagrees for the reasons detailed above, i.e., *Robles* does not teach such.

The Examiner also appeared to state that the *Robles* disclosure of intermittent bonding teaches varying those bond sizes.¹³ Appellant respectfully disagrees. “Intermittent bonding” implies only that the bonds are spaced from each other. The term is not related at all to bond size.

The Examiner further argued that the sizes and shapes of the internal bonds within the side panel are result-variable parameters that can be optimized.¹⁴ Assuming *arguendo* that the sizes of the *Robles* internal bonds are indeed optimizable, it would still not have been obvious to apply that teaching of *Robles* to a completely different element, i.e., the external bonds between the side panel 30 and the diaper assembly.

Since *Robles* is not properly modifiable in the manner suggest by the Examiner, the reference fails to teach or suggest the claim features “the fixing part extends continuously along substantially an entire length, as measured in the longitudinal direction, of the inner edge of the inner end of the respective side flap, and a length, as measured in the longitudinal direction, of each of the first and second joint parts is shorter than half of that of the fixing part.”

¹¹ Examiner's Answer, at the paragraph bridging pages 12-13.

¹² Examiner's Answer, at the sentence bridging pages 12-13.

¹³ Examiner's Answer, a page 12, the last two lines.

¹⁴ Examiner's Answer, at page 13, lines 3-7.

Claims 22-23

The Examiner has essentially raised new grounds of rejection against claims 22-23.¹⁵

The new grounds of rejection are traversed for at least the reasons detailed above with respect to claim 1.

Claim 24

As to claim 24, the Examiner appeared to argue ¹⁶ that in *Robles* the area directly above the top edge of the fastener 40 (best seen in FIGs. 2-3) is readable on the claimed first joint part, the area directly below the lower edge of the fastener 40 is readable on the claimed second joint part, and therefore, the fastener 40 is not co-elevational with any portion of such first and second joint parts.

Appellant respectfully submits that it is unclear as to how the Examiner's interpretation would meet another claim requirement that "the second joint part being spaced in the longitudinal direction from the first joint part by a section of the bonding-free region." There is no evidence in *Robles*, given the sizes of fastener 40 and inner edges 80 along which the side panel 30 is bonded to the diaper assembly, that the region between "the area directly above the top edge of the fastener 40" and "the area directly below the lower edge of the fastener 40" is, or would have been obvious to be, a bonding free region.

Claim 25

Claim 25 is patentable over *Robles* for at least the reason advanced above with respect to claim 24 that there is no evidence in *Robles*, given the sizes of fastener 40 and inner edges 80 along which the side panel 30 is bonded to the diaper assembly, that the region between "the area directly above the top edge of the fastener 40" and "the area directly below the lower edge of the fastener 40" is, or would have been obvious to be, a bonding free region.

¹⁵ Compare, for example, the rejections of claim 22 in Examiner's Answer, at the paragraph bridging pages 7-8 and at page 13, the first full paragraph.

¹⁶ Examiner's Amendment, at page 14, the last full paragraph.

Claim 26

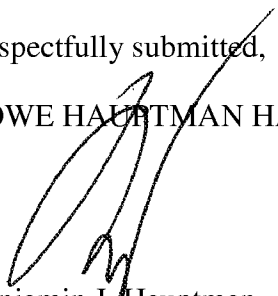
The claim is patentable for at least the reasons detailed above with respect to claims 24 and/or 25.

Consideration of this reply brief together with the previously submitted Appeal Brief is respectfully requested. Reversal of the Examiner's Final Rejection, in view of the arguments presented in the Appeal Brief and this Reply Brief, is believed appropriate and therefore courteously solicited.

If for any reason this Reply Brief is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned, Appellant's attorney of record.

Respectfully submitted,

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